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SERIAL NO.: 09/780,470
FILED: February 12, 2001
ASSIGNEE: Intel Corporation
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REMARKS

Claim Rejections - 35 USC §103

In the Office Action, the Examiner rejected claims 1-5, 8, 9, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Kornfeld et al. (US Patent 5,758,266) in view of Hottinen (US Patent 5,936,950). The Examiner contends that Kornfeld et al. discloses all the limitations of claims 1-5, 8, 9, 12 and 13, for example, "interrupting reception from a first communication system", in e.g., the Abstract, at Col. 1, lines 50-63, at Col. 2, lines 36-51, and at Col. 3, lines 13-18; except that Kornfeld et al. does not disclose a second communication system that operates according to a different communication standard than a first communication system. The Examiner further contends that Hottinen discloses a second communication system that operates according to a different communication standard than a first communication system.

As is well established, an obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (MPEP 2142). Without conceding the appropriateness of the combination of Kornfeld et al. and Hottinen, applicants respectfully submit that this combination does not meet the requirements of an obviousness rejection. In view of the arguments below, applicants respectfully assert that neither Kornfeld et al. nor Hottinen, alone or in combination, teach or suggest the limitations of claim 1, and therefore a *prima facie* case of obviousness has not been established by the Examiner with respect to claim 1.

Independent claim 1 of the present application recites, *inter alia*, "interrupting reception from a first communications system". This feature of claim 1 is not described, suggested, or implied by either Kornfeld et al., or Hottinen, or by any other prior art on record. Specifically, applicants could not find a teaching of this feature of claim 1 in the portions of Kornfeld et al. cited by the Examiner, i.e., in the Abstract, at Col. 1, lines 50-63, at Col. 2, lines 36-51, and at Col. 3, lines 13-18.

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As to Hottinen, the Examiner has not cited this reference as curing and, in fact, the reference does not cure the deficiencies identified above in the Kornfeld et al. reference. In this regard, without conceding the appropriateness of the combination of Kornfeld et al. and Hottinen, or the characterization of such references vis-a-vis claim 1, applicants respectfully submit that the combination of Kornfeld et al. and Hottinen references fails to teach or fairly suggest that which is claimed in independent claim 1.

Furthermore, as discussed below, applicants respectfully assert that both Kornfeld et al. and Hottinen references teach away from "interrupting reception from a first communication system" as recited in claim 1.

For example, as an indication contrary to the Examiner's reading of the cited Kornfeld et al. reference, at Col. 3, lines 9-11 Kornfeld describes that "at all times throughout the soft hand-off process, no interruption in communications occurs". Applicants' view that Kornfeld et al. does not teach interruption of communication is further supported by the language at Col. 4, lines 61-63 that "there are two mixing paths (110 and 115) enabling the radio to communicate on two different frequencies simultaneously". Further support of applicants' above position can be found at Col. 5, lines 53-55, where Kornfeld et al. suggests to "use more down converting paths if it is desired to communicate with more than two base stations simultaneously". The above cited portions of Kornfeld et al. clearly indicate that Kornfeld et al. teaches away from interrupting reception from a first communication system, as required by independent claim 1 of the present application.

Hottinen also teaches away from interrupting reception from a first communication system, for example, in describing "simultaneous joint detection of signals transmitted by one or more multiple access methods" (Col. 2 lines 30-32), and suggesting to "utilizes simultaneous joint detection of a plural number of signals by e.g. multi-user detection methods" (Col. 2 lines 46-48).

Applicants further submit that none of the other cited references teaches, suggests, or implies "interrupting reception from a first communications system" as are required by claim 1 and, therefore, claim 1 is not rendered obvious by the prior art of record.

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Claims 2-5, 8 and 9 depend, either directly or indirectly, from claim 1 and include all the features of claim 1 as well as additional distinguishing features of the invention. Therefore, it is respectfully submitted that none of claims 2-5, 8 and 9 is rendered obvious by Kornfeld et al. and/or Hottinen, alone or in combination with any other prior art references.

Independent claim 12 recites, *inter alia*, "a processor to interrupt reception from a first communication system". It will be appreciated that this feature of the processor in claim 12 corresponds to the distinguishing feature of independent claim 1 discussed above. Therefore, in view of the above arguments relating to claim 1, it is respectfully submitted that neither Kornfeld et al. nor Hottinen, alone or in combination, teach or suggest at least the processor recited in claim 12, and thus a *prima facie* case of obviousness has not been established by the Examiner with respect to claim 12.

Claim 13 depends from claim 12 and includes all the features of claim 12, as well as additional distinguishing features. Therefore claim 13 is patentable over the prior art at least for the reasons discussed above with reference to claim 12.

In view of the preceding remarks, applicants respectfully request that the rejection of claims 1-5, 8, 9, 12 and 13 under 35 U.S.C. §103(a) be withdrawn.

The Examiner also rejected claims 6 and 14-19 under 35 U.S.C. §103(a) as being unpatentable over Kornfeld et al. in combination with Hottinen in view of Vilmur (US Patent 5,950,131). Specifically, the Examiner contends that all the features of claims 6 and 14-19 have been disclosed by Kornfeld et al. in combination with Hottinen, and further in view of Vilmur.

The Examiner also rejected claim 7 under U.S.C. §103(a) as being unpatentable over Kornfeld et al. in combination with Hottinen in view of Rotstein et al. (US Patent 6,289,228). Specifically, the Examiner contends that all the features of claim 7 have been disclosed by Kornfeld et al. in combination with Hottinen, and further in view of Rotstein et al.

Claims 6 and 7 depend from claim 1 and include all the limitations of claim 1, as well as additional distinguishing features, and so are patentable, at least, for the reasons discussed above with reference to claim 1. Claims 14-19 depend from claim 12 and include all the

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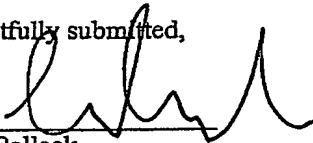
limitations of claim 12, as well as additional distinguishing features, and so are patentable, at least, for the reasons discussed above with reference to claim 12.

In view of the preceding remarks, applicants respectfully request that the rejection of claims 6, 7 and 14-19 under 35 U.S.C. §103(a) be withdrawn.

In view of the foregoing remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the remarks, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved in order to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,


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